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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,674	02/02/2001	Timothy M. Richardson	1960.30 DIV. I	7351
33721	7590	07/14/2005	EXAMINER	
TORYS LLP 79 WELLINGTON ST. WEST SUITE 3000 TORONTO, ON M5K 1N2 CANADA			VALENTIN, JUAN D	
			ART UNIT	PAPER NUMBER
			2877	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,674

Applicant(s)

RICHARDSON, TIMOTHY M.

Examiner

Juan D. Valentin II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-26 and 39-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39-49 is/are allowed.
- 6) ☒ Claim(s) 14-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/22/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 14-18, 23, & 24 rejected under 35 U.S.C. 102(a) as being anticipated by Hoch et al. (Nanofabrication and Biosystems, hereinafter Hoch).

Claims 14-18, 23, & 24

Hoch discloses providing a cover glass substrate (cover slip, page 125, line 10-page 126, line 2), coating the substrate with a metal layer, coating the metal layer with a resist, and exposing the resist to form a test pattern. Further Hoch discloses developing the resist compound and removing portions of the resist, metal layer, and substrate to form the test pattern and locating pattern. The exposure step of Hoch is accomplished optically. Further, the remaining resist of the Hoch test pattern was removed to leave the remaining unexposed parts of the metal layer as the test patterns (page 126, section 8.2.1).

2. Claims 14 & 18-21 rejected under 35 U.S.C. 102(a) as being anticipated by Canestrari et al. (USPN '796, hereinafter Canastrari).

Claims 14 & 18-21

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Canestrari discloses providing a substrate, coating the substrate with a resist layer, and exposing the resist to form a test pattern. Further Canestrari discloses developing the resist compound and removing portions of the resist (Fig. 1a, ref. 2), and substrate (Fig. 1b, ref. 3) to form the test pattern and locating pattern (Fig. 1c, ref. 4). The exposure step of Canestrari is accomplished optically with focused energy beams. Further, Canestrari also removed part of the substrate during the resist removal step. Canestrari used chemical etching to remove portions of the substrate. Canestrari further discloses metallizing the substrate after the resist removal process and removing the metallization from the surface such that the metallization remains in depressions formed by the removal of selected portions of the substrate (Fig. 1f, ref. 5, col. 4, lines 9-36).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Canestrari.

Claims 22

Canestrari discloses the claimed invention except it fails to show polishing the metal layer from the surface of the substrate. It would have been obvious to someone of ordinary skill in the art at the time of the claimed invention to combine Canestrari with the removal the metal layer by polishing since it was well known in the art that polishing layers off of semiconductor

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substrate surfaces helps prevent damage or removal of the substrate layer. Accordingly, such modification would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made.

4. Claims 25 & 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Hoch.

Claims 25, & 26

Hoch discloses the claimed invention except it fails to show the cover glass (cover slip) mounted on a slide with a solvent inbetween the two. Official notice taken. It would have been obvious to someone of ordinary skill in the art at the time of the claimed invention to mount the cover glass of Hoch on microscope slide using some form of solvent in order to help seal the mounting, protect both the slide and cover glass from environmental damage, and to aid in aligning the slide under a microscope objective.

Allowable Subject Matter

5. Claims 39-49 are allowed over prior art of record.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 39-49, please see section 6 of the non-final rejection sent out 10/28/2004.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

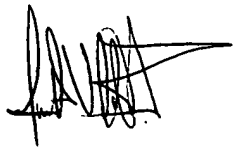
"Several facts have been relied upon from the personal knowledge of the examiner about which the examiner took Official Notice. Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made by the Board of Patent Appeals and Interferences. In re Selmi, 156 F.2d 96, 70 USPQ 197 (CCPA 1946); In re Fischer, 125 F.2d 725, 52 USPQ 473 (CCPA 1942). See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice). If applicant does not seasonably traverse the well-known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well-known statement in the next reply after the Office action in which the well known statement was made."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juan D. Valentin II whose telephone number is (571) 272-2433. The examiner can normally be reached on Mon.-Fri..

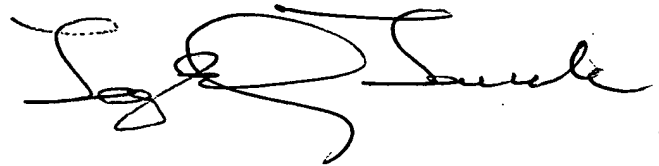
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr. can be reached on (571) 272-2800 ext. 77. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Juan D Valentin II
Examiner 2877
JDV
July 9, 2005



Layla Lauchman
Primary Examiner 2877